

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT
APPLICATION OF: ANDREW ROUSE, et al.
SERIAL NO.: 09/750,320
FILING DATE: December 29, 2000
ART UNIT: 2618
EXAMINER: PAN, YUWEN
FOR: SYSTEM AND METHOD FOR PROVIDING WIRELESS DEVICE
ACCESS

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed April 15, 2010 ("Answer"), Appellants respectfully submit a Reply Brief pursuant to 37 C.F.R. § 41.41.

It is not believed that any fees are due in this case. However, the Director is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same to Deposit Account No. 033975 (**Ref. No. 042846-0313440**).

REQUIREMENTS OF 37 C.F.R. §41.41

I. 37 C.F.R. § 41.37(c)(1)(iii) – STATUS OF CLAIMS

Pending: Claims 21, 22, 24-30, 32-35, 37-39, and 41-44 are pending.

Cancelled: Claims 1-20, 23, 31, 36, and 40 have been cancelled without prejudice or disclaimer.

Rejected: Claims 21, 22, 24-30, 32-35, 37-39, and 41-44 stand rejected.

Allowed: No claims have been allowed.

On Appeal: The rejections of claims 21, 22, 24-30, 32-35, 37-39, and 41-44 are appealed.

II. 37 C.F.R. § 41.37(c)(1)(vi) – Grounds of Rejection to be Reviewed on Appeal.

Claims 21, 22, 25-30, 32-35, 37-39, and 42-44 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,633,759 to Kobayashi (“Kobayashi”) in view of U.S. Patent No. 6,052,735 to Ulrich *et al.* (“Ulrich”), and claims 24 and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kobayashi in view of Ulrich, and in further view of U.S. Patent No. 6,308,061 to Criss *et al.* (“Criss”). These rejections constitute legal error, and should be reversed upon review.

III. 37 C.F.R. § 41.37(c)(1)(vii) – ARGUMENT

A. CLAIMS 21 AND 38 (and their dependent claims)

It is well established that “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.”¹ In order to establish a *prima facie* case of unpatentability the Examiner must show that the references teach or suggest all of the features of the claimed invention.²

The Examiner has failed to demonstrate that Kobayashi and/or Ulrich teach or suggest all of the features of the claimed invention. For example, claims 21 and 38 recites *inter alia* the following features, which are not taught or suggested by the cited portions of Kobayashi and/or Ulrich:

...executing the at least one selected application action on the at least one server, **the application action comprising at least one or more of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, or searching at least one file within the server;** [and]

[] formatting at least one application output **associated with the at least one selected application actions** based on a profile of the wireless client device and a user selection of one or more fields associated with the at least one file....

1. The Cited Sections Of Kobayashi.

In the Answer, the Examiner alleges that Kobayashi teaches “a communication system that allows [a] mobile communication device to access application or software on the server/computer” [p. 9 (emphasis added)]. In support of this characterization of the teachings of Kobayashi, the Examiner reproduces several passages of Kobayashi describing how a cellular telephone can be used to access software applications running on a nearby laptop computer [pp. 9-10]. In order to make the visual output of the software applications viewable on a cellular telephone, Kobayashi teaches that the output of the software application should be modified by, for example, changing

¹ *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (discussing *In re Piasecki*, 745 F.2d 1468, 1472, (Fed. Cir. 1984)).

character font and/or removing a portion of the output data [Kobayashi, c. 10, l. 65-c. 11, l. 3].

The Examiner acknowledges that there is no teaching or suggestion in Kobayashi of formatting the visual output of software applications “based on a profile of the [cellular telephone] and a user selection of one or more fields associated with the at least one file.”

2. The Cited Sections Of Ulrich.

The disclosure of Ulrich is directed to the synchronization of email between a desktop computer and a mobile device [see, e.g., the Abstract]. One of the aspects of synchronization discussed in Ulrich is the retrieval of files attached to emails on the mobile device [see, e.g., *id.*]. The sections of Ulrich relied upon in the Office Action describe an embodiment in which files attached to emails are converted into a format readable by the mobile device before being forwarded [p. 10 (*citing* Ulrich at c. 14, ll. 7-19)].

The Examiner further cites another section of Ulrich that discusses how a user interface of the mobile device can be used to manage files within the email account [pp. 9-10 (*citing* Ulrich at c. 12, l. 57-c. 13, l. 11)]. This may include copying, moving, or deleting the files [Ulrich at c. 12, l. 57-c. 13, l. 11].

3. The Cited Sections Of Ulrich Do Not Teach Or Suggest The Features Acknowledged As Missing In Kobayashi.

It will be apparent that the “formatting” described in Ulrich is completely different from the type of “formatting” performed in Kobayashi and/or the type of “formatting” recited in claims 21 and 38. Kobayashi describes the formatting of visual content by changing font size and/or removing visual objects. The formatting described in Kobayashi is performed, as the Examiner acknowledges, to provide “access to application or software” being executed on a laptop for a cellular telephone. This enables presentation, on the cellular telephone, of visual output of the application or software executing on the laptop.

² *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The cited portions of Ulrich, on the other hand, describe the conversion of a file format for files attached to email messages [c. 14, ll. 7-19]. Such conversion, if performed correctly, should not even effect the visual appearance of the content within the document (e.g., conversion of a .DOC file to a .RTF or .DOCX file format). Further, the cited sections of Ulrich are not at all concerned with providing access to software applications being executed on another computer involving the converted files. Instead, the formatting described in Ulrich is concerned with converting an electronic file into a format so that it can be opened and manipulated by an application being executed locally on the mobile device.

One of ordinary skill in the art would have understood the alteration of visual content in Kobayashi and the file format conversion in Ulrich to be two very different processes performed for very different reasons. The proposed combination of Kobayashi with Ulrich is an improper attempt by the Examiner to leverage the fact that the word “formatting” has more than one meaning into grounds for a legal determination of obviousness. While the alteration of visual content may be referred to in some instances as the “formatting” of the visual content, such alteration is independent of the file “format” of an electronic file containing the visual content. Similarly, an electronic file can be “reformatted” without significantly impacting the visual content contained within the electronic file. In fact, generally speaking it is desirable to execute a file format change without making any changes to the underlying content.

The sections of Kobayashi cited in the Office Action are directed to the alteration of visual content generated on a laptop to permit display on a cellular telephone, not the conversion of files so that they can be manipulated locally on the cellular telephone. This is even acknowledged by the Examiner. Therefore, the sections of Ulrich cited by the Examiner describing a file format change for files attached to email messages are not relevant to the admitted deficiencies of Kobayashi with respect to claims 21 and 38. Even if the conversion of electronic files described in the cited sections of Ulrich is made based on “based on a profile of the mobile device and a user selection of one or more fields associated with the at least one file”, it would not have been obvious to one of ordinary skill in the art to modify the cited sections of Kobayashi in performing a completely different kind of operation (the alteration of visual content).

As such, the Examiner has failed to demonstrate that the portions of claims 21 and 38 reproduced above would have been obvious in light of the combined teachings of Kobayashi and Ulrich. For at least this reason the rejection of claims 21 and 38 under § 103 constitutes legal error and should be reversed.

B. CLAIMS 24 AND 41

1. The Cited References Do Not Teach Or Suggest The Features Of Claims 24 And 41.

The rejection of claims 24 and 41 based on the proposed combination of Kobayashi, Ulrich, and Criss constitutes legal error at least because the Examiner has failed to demonstrate that the proposed combinations teaches or suggests the following features:

...the profile of the wireless client device comprises at least one of a feature of the wireless client device or a device type of the wireless client device.

The Examiner acknowledges that Kobayashi and Ulrich do not teach or suggest these features [the Answer, p. 7]. The cited sections of Criss address this acknowledged deficiency of Kobayashi and Ulrich [the Appeal Brief, pp. 14-15].

In the Answer, the Examiner relies on FIG. 5A of Criss as teaching “that packet information comprising [sic] the version ID of software, memory, and mode is sent to the server” [p. 10]. The Examiner alleges that “[t]his packet information is same [sic] as the feature of the mobile device in which provides [sic] to the server such that the server understands the capacity of the mobile device before the server transfer [sic] data information to the mobile device for upgrade” [p. 11].

This constitutes legal error because FIG. 5A of Criss provides an illustration of package definition files stored in a host computer that represent features of the software that is to be installed on the mobile device, not features of the mobile devices [c. 10, ll. 1-54]. In particular, the supposed “capacity” in the package definition file relied on in the Answer appears to refer to “an indication of the total memory occupied by the operating software associated with the package name” [c. 10, ll. 20-23]. Again, this is a feature of the software, and not a feature of a mobile device. Therefore, the sections of Criss

relied on in the Answer fail to address the acknowledged deficiencies of Kobayashi and Ulrich. For at least this reason the rejection of claims 24 and 41 under § 103 constitute legal error and must be reversed.

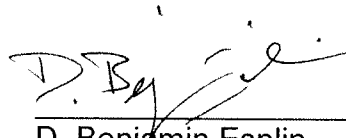
CONCLUSION

For at least the foregoing reasons, Appellant respectfully requests that the rejection of each of claims 21, 22, 24-30, 32-35, 37-39, and 41-44 be reversed.

Date: June 15, 2010

Respectfully submitted,

By:



D. Benjamin Esplin
Registration No. 58,297

Customer No. 00909

Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500
McLean, Virginia 22102
Main: 619-234-5000